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IN THE  
**Supreme Court of the United States**

OCTOBER TERM 1944.

—  
No. **970**  
—

CONDENSER CORPORATION OF AMERICA, *Petitioner,*

v.

MICAMOLD RADIO CORPORATION, *Respondent.*

—  
**PETITION OF CONDENSER CORPORATION OF AMERICA FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.**  
—

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*To the Honorable the Chief Justice of the United States and  
the Associate Justices of the Supreme Court of the  
United States:*

Your petitioner, Condenser Corporation of America, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit to review the judgment of that Court entered on November 30, 1944. A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the Rules of this Court.

## SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

(1) This is a patent infringement suit brought by Condenser Corporation of America, a corporation of New York, against Micamold Radio Corporation, a corporation of New York, on Letters Patent No. 1,940,847, granted December 26, 1933 to Harold I. Danziger for Apparatus for Winding Coil Condensers (R. 235). The claims in suit are 1, 2, 3, 9, 10, 11 and 12.

(2) The patent in suit is concerned with a machine for winding electrical condensers from alternate strips of paper and very thin and fragile metal foil (R. 215, finding 11). The strips are taken from separate rolls and wound together on a mandrel to form a coil, and when a predetermined amount of paper and foil have gone into the coil so that the coil will satisfy certain definite electrical requirements, the strips are automatically cut off. The Danziger machine provided manufacturers of coil condensers with their *first automatic machine*, removing the human factor as a source of error in handling and cutting the strips to the right length, as well as a cause of dirt and grease getting onto the strips, with the consequent alteration of the electrical characteristics of the condensers (R. 215, finding 16).

(3) Both petitioner and respondent are manufacturers of condensers. Petitioner acquired title to the patent in suit in June 1940, but had been operating under this patent as a licensee since June 1934, and has continued to operate thereunder, by winding coil condensers on machines built under this patent (R. 13, 260).

(4) Prior to assigning the patent in suit to petitioner, Danziger had made and sold to manufacturers of coil condensers approximately 100 winding machines substantially conforming to the disclosure of the patent in suit, and he also granted licenses to condenser manufacturers among

which were Western Electric Company, General Electric Company and RCA Manufacturing Company (R. 260, 261). Respondent first acquired thirteen of the Danziger machines (R. 98) and thereafter, without the authorization of Danziger or petitioner, converted certain hand operated winding machines into automatic machines, thereby infringing the patent in suit (R. 102, 115).

(5) On February 10, 1941, petitioner filed its complaint against respondent in the United States District Court for the Eastern District of New York. This case was duly tried before the late Judge Marcus B. Campbell who, on January 24, 1944, filed his opinion (R. 194), and also findings of fact and conclusions of law (R. 213), holding claims 1 to 3 and 9 to 12 of the patent in suit to be valid and infringed. Respondent then appealed to the Second Circuit Court of Appeals, and the latter on November 30, 1944 entered its judgment reversing the District Court and holding claims 1 to 3 invalid and claims 9 to 12 not infringed.

(6) Prior to Danziger's invention of the automatic machine of the patent in suit coil condensers were made by rolling the alternating strips of foil and paper into a coil, and then the paper and foil strips were cut to desired, relative lengths by hand. To avoid contact between adjacent foil strips, the end of the intermediate paper must be cut to a length projecting beyond at least one of the foil ends, and in order that the electrical characteristics of the condenser shall adhere closely to standard requirements, the amount of paper and foil going into each condenser should be nicely controlled. Cutting of the strips should thus be a precision operation. Prior to Danziger the hand-cutting of the strips, as by shears, not only involved some handling, with resultant soiling of the strips, but it also resulted in variations in the amount of paper and foil going into different condensers, with consequent variations in the electrical characteristics of the condensers (R. 215).

(7) Hand-operated winding machines were known at least as early as 1905. The Siemens British patent No. 13,682 of 1905, which was the only patent relied upon by the Second Circuit Court of Appeals in holding claims 1 to 3 of the patent in suit to be invalid, was a hand operated winding machine seen in use by one of petitioner's witnesses at the British plant of Siemens Brothers & Company in 1910 and again in 1918 (R. 216). The foil cutter shown in the British patent was not operative, and the strips of foil and paper were cut by the operator with scissors (R. 170). Not until twenty years later, when Danziger produced his machine in 1925, was automatic operation introduced.\*

(8) The Siemens British patent was also cited by the Patent Office to show the state of the prior art, and the claims in suit were allowed over this patent (R. 197). Neither the Patent Office nor respondent has shown the existence of an automatic winder prior to Danziger.

(9) The Second Circuit Court of Appeals, however, held claims 1 to 3 to be invalid as involving no invention over the Siemens disclosure. It conceded that the history of the art should be looked to in deciding the issue of invention, and agreed that knowledge of the Siemens British patent must at least be imputed to Danziger to determine the measure of his step forward. But it then proceeded to reason that there was no presumption that the rest of the art knew of the Siemens disclosure; it apparently overlooked the evidence as to the use of this machine in the Siemens plant, asserting " \* \* \* it does not appear that the Siemens disclosure was ever exploited, or became

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\* Judge Campbell said (R. 199): " \* \* \* I am impressed by the fact that the Siemens Patent was accepted October 12th, 1905, and with the desire there was for an automatic condenser winder, the Siemens Patent was not availed of, and there was no satisfactory automatic condenser winder on the market until Danziger, the patentee of the patent in suit, produced the first satisfactory automatic condenser winder."



known to the art in any other way;" and with what is believed to be a misinterpretation of this Court's decision in *Goodyear Tire & Rubber Company v. Ray-O-Vac*, 321 U. S. 275, 278, 279, it arrived at the conclusion that lapse of time is not important " \* \* \* until it appears that the art in fact knew the earlier steps, already taken". Thus it imposed on the patentee the improper burden not only of showing as a fact that the art had a familiarity with the British patent over and above its status of being a publication to the world of a patented invention, but also of explaining why persons familiar with the Siemens disclosure had not earlier met the need and demand for an automatic machine.

(10) In view of the delicate nature of the strips to be cut, Danziger's automatic machine included a provision for introducing a momentary tension on the strips at the instant when they are cut, so as to overcome the tendency of the strips to be pushed away from the knives at the instant of cutting. Claims 9 to 12 are combination claims including this provision.

(11) Respondent's machine complained of includes a pair of rolls which are operated to pinch one foil strip and the associated paper strips "At or just prior to the time when cutter 1 operates, \* \* \* " (stipulated description R. 41). It was further stipulated "The machine is adjusted as accurately as possible so that the cutter 1 cuts at the time rolls 4 pinch together". This would impose tension on the strip for any condenser larger than 0.273 inch in diameter (R. 207). Respondent concededly makes condensers of such larger diameter.

(12) Respondent's machines thus included a provision for imposing the claimed tension, and respondent's making of these machines was in itself infringement of the patent in suit. However, use of the machine in making condensers having a diameter larger than 0.273 inch also involved infringement by use, even if the machine was used in an

infringing way only part of the time. Accordingly, the Court below held that claims 9 to 12 were infringed.

(13) The Second Circuit Court of Appeals, however, after conceding that “\* \* \* it is true that there may be, and probably is, some such tension at the later stage of the winding of the larger condensers, and the Judge so found”, and further agreeing that the intent of the infringer is not material, and apparently agreeing that a machine which infringes part of the time is none the less an infringing machine, ruled that “\* \* \* there comes a point where what may be literally a wrong is of too trifling importance to justify the intervention of a court”. It accordingly entered its judgment that the claims in suit were not infringed, in disregard of the law that the building of these machines was in itself an infringement, while the extent of use goes to the quantum of recovery rather than the fact of infringement.

### **JURISDICTION.**

Jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925; USC Title 28, Section 347(a). The judgment of the Circuit Court of Appeals was entered November 30, 1944.

### **QUESTIONS PRESENTED.**

(1) Whether the Circuit Court of Appeals for the Second Circuit erred in holding that while Danziger is presumed to have known of the Siemens disclosure for the purpose of determining the magnitude of his step forward, he must prove that the rest of the art knew of the Siemens disclosure and must show why the art in spite of this knowledge failed to go forward from the Siemens disclosure to produce an automatic machine, and in so misinterpreting or misapplying the ruling of this Court in *Goodyear Tire & Rubber Company v. Ray-O-Vac*, 321 U. S. 275.

(2) Whether the Circuit Court of Appeals for the Second Circuit erred in entering a judgment of noninfringement notwithstanding that respondent made the machines complained of with the capacity for infringing use and used them in an infringing way for at least part of the time, and in speculating on the value of the involved function in the face of its adoption and use by respondent.

(3) Whether the Circuit Court of Appeals for the Second Circuit erred in holding claims 1 to 3 of the patent in suit invalid, and not holding each of them valid and infringed, and in holding claims 9 to 12 of the patent in suit not infringed, and not holding each of them valid and infringed, as decreed by the District Court for the Eastern District of New York, in view of the findings of fact of the trial court and the weight to be accorded them under the ruling of this Court in *Adamson v. Gilliland*, 242 U. S. 350, 353.

### **REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.**

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

(1) The Second Circuit Court of Appeals misinterpreted or unduly limited this Court's decision in *Goodyear Tire & Rubber Company v. Ray-O-Vac*, 321 U. S. 275, by reversing the District Court, whose decision conformed with the rulings of this Court, in its conclusion that the history of the art demonstrated that Danziger had made an invention in providing the combinations defined by claims 1 to 3. When the history of an art shows an unsatisfied need for a given development, this has long been recognized as persuasive evidence that it required an inventor to take the requisite step. The Second Circuit Court of Appeals has in effect shifted the burden from the defendant of establishing the invalidity of a patent (*Radio Corporation of America, et al., v. Radio Engineering Laboratories, Inc.*,

293 U. S. 1, 2 and 7) and imposed on the plaintiff the necessity of showing why others in the art failed to advance it before the advance can be taken as inventive. This is a question of wide public interest going to the validity of every extant patent.

(2) The Second Circuit Court of Appeals departed from the accepted and usual course of judicial proceedings, and is in conflict with the decisions of other Courts of Appeals, when it entered a judgment of noninfringement in disregard of the findings below that respondent had made the machines complained of with the capacity to infringe and there was infringing use at least part of the time. A given machine either infringes or it does not infringe. If it infringes the decree should be in conformity with the fact, and the Second Circuit Court of Appeals was in error when it reversed the lower court, not on the ground of disagreement with the finding that infringement had occurred, but because it substituted its own intuition that the value of the involved subject matter is small.

(3) Petitioner has pending two suits against the only other known infringers, one in the Southern District of New York and one in the Eastern District of New York, but as both of these suits are in the Second Circuit there is no apparent opportunity for further litigation that may result in a conflict of opinion between different Circuit Courts of Appeals. In view of the sharp diversity of opinion between the Second Circuit Court of Appeals and the trial Judge with respect to both validity and infringement of the Danziger patent in suit, and the likelihood that the patent in suit cannot be further litigated if the judgment of the Second Circuit Court of Appeals is allowed to stand, review by this Court is believed to be warranted under such decisions as:

*Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U. S. 47; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Altoona*

*Publix Theatres, Inc. v. American Tri-Ergon Corp., et al.*, 294 U. S. 477.

**PRAYER.**

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Second Circuit be reversed; and that petitioner be granted such other and further relief as may be proper.

CONDENSER CORPORATION OF AMERICA

By LOYD H. SUTTON,  
*Attorney for Petitioner.*



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**BRIEF IN SUPPORT OF PETITION FOR WRIT OF  
CERTIORARI.**

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**OPINIONS BELOW.**

The opinion of the Circuit Court of Appeals for the Second Circuit is reported at 145 F. (2d) 878 and is found at the end of the accompanying record.

The opinion of the District Court is reported at 54 F. Supp. 327, and also appears at R. 194.

**JURISDICTION.**

The judgment of the Circuit Court of Appeals was entered November 30, 1944.

The statute giving jurisdiction is Section 240(a) of the Judicial Code (28 USC Sec. 347) as amended by the Act of February 13, 1925.

## STATEMENT OF THE CASE.

The foregoing petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for urging the allowance of the writ as well as a statement of the questions involved in the case.

## SPECIFICATION OF ERRORS.

(1) The Circuit Court of Appeals for the Second Circuit erred in holding claims 1 to 3 of the Danziger patent in suit invalid on the ground that, notwithstanding the history of the art, invention had not been shown in providing the combination defined by said claims, and in misinterpreting or failing to follow the decision of this Court in *Goodyear Tire & Rubber Company v. Ray-O-Vac*, 321 U. S. 275.

(2) The Circuit Court of Appeals for the Second Circuit erred in holding claims 9 to 12 of the Danziger patent in suit not infringed notwithstanding the evidence that respondent had made the machines complained of with the capacity for infringement and that said machines operated in an infringing manner for at least part of the time.

(3) The Circuit Court of Appeals for the Second Circuit erred in reversing the District Court, and not affirming the judgment of the District Court, in holding claims 1 to 3 and 9 to 12 of the Danziger patent in suit valid and infringed, in view of the ruling of this Court in *Adamson v. Gilliland*, 242 U. S. 350.

## ARGUMENT.

### Point 1. Improper Imposition of Burden on Petitioner to Show Patentable Invention.

Although the need for eliminating the human factor in winding coil condensers, so as to avoid variable electrical characteristics arising from soiling the foil and lack of precision in accurately cutting the lengths of the strips



under hand operation, had long been recognized, the Danziger machine of the patent in suit was the *first automatic machine* for winding coil condensers (R. 199, 215, finding 16). Twenty years had elapsed between the date of the closest earlier art (Siemens British patent No. 13,682 of 1905) and the invention of the Danziger machine of the patent in suit. This invention promptly received an impressive acknowledgment, that it met the need and demand of the art, from the licenses under the patent in suit acquired by such companies as Western Electric Company, General Electric Company and RCA Manufacturing Company (R. 13) as well as by the sale of approximately 100 of these machines (R. 260). The Court of Appeals considered that the sale of approximately 100 machines was not impressive, but it apparently overlooked the fact that these machines operating on an assumed working day of seven hours, with two hundred working days per year, had a capacity of producing coil condensers on the order of from forty to fifty million a year (R. 191, XQ. 118). With the increased capacity for production of these automatic machines, the requirements of the trade for coil condensers could be satisfied without such a large number of machines as the Court of Appeals was apparently looking for.

The nearest prior art to the Danziger machine found by either the Patent Office or by respondent was that of the Siemens British patent No. 13,682 of 1905. This patent was duly considered by the Patent Office and the claims in suit allowed thereover (R. 216), and the District Court agreed with the Patent Office that the Danziger machine was an invention over the disclosure of this British patent. The machine of this British patent was hand-operated, and it was in use in the Siemens factory in 1910 and 1918 (R. 216), so that contrary to the implication of the Court of Appeals this machine did have a commercial history. As a hand-operated machine it was imbued with all of the disadvantages incident to that type of operation, yet for twenty years, 1905 to 1925, it represented the highest state of development of machines for winding coil condensers.

Notwithstanding the foregoing historical background the Court of Appeals, by sole reliance on this British patent of 1905, found claims 1, 2 and 3 in suit to be invalid, taking the position that there was no presumption that the art knew about the Siemens machine, and in the absence of a showing that "the art in fact knew the earlier steps" taken, a conclusion of invention could not be reached. This decision in effect imposes on the plaintiff the burden of not only showing a long unsatisfied demand, but that the workers in the art knew its highest development and still could not meet the demand.

The term "invention" is not capable of certain definition (*McClain v. Ortmyer*, 141 U. S. 419, 427). Hence the Courts have consistently examined the *res gestae* of the invention to determine whether the advance apparently required more than the skill of a mechanic.

The patent as granted is presumptively valid (*Westinghouse Electric & Manufacturing Company v. Formica Insulation Company*, 266 U. S. 342, 348) and it is presumed "until the contrary appears, that all the conditions under which a discovery is patentable in accordance with the statutes have been met" (*Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171). Hence the burden is on the defendant in an infringement suit to sustain an allegation of non-invention (*Cantrell v. Wallick*, 117 U. S. 689, 695).

The foregoing presumption of validity is greatly strengthened when the very patent relied upon by the defendant to support its allegation of no invention is the same patent over which the claims in suit were allowed by the Patent Office. This has been recognized by the Courts of Appeals of most if not all of the Circuits—see *Williams Mfg. Co. v. United Shoe Machinery Corporation*, 121 F. (2d), 273, 277, C. C. A. 6, affirmed 316 U. S. 364; *Hartford-Empire Co. v. Obear-Nester Glass Co.*, 71 F. (2d) 539, 560, C. C. A. 8; *Gray v. Eastman Kodak Co.*, 67 F. (2d) 190, 195, C. C. A. 3; and in fact had been recognized by earlier decisions of the Second Circuit Court of Appeals, as see

*Ensign Carburetor Co. v. Zenith-Detroit Corporation*, 36 F. (2d) 684, 686. In the instant case, however, *the only patent in the prior art relied upon by the Second Circuit Court of Appeals* (Siemens British patent of 1905) *was the very patent over which the claims in suit had been allowed by the Patent Office.*

This Court, when confronted with the question of invention, has repeatedly turned to the history of the art, and when the record showed a long period of unsatisfied demand prior to the patent in suit, it has recognized that the mechanics of the art would previously have satisfied such need if the mere skill of the art had been sufficient to do so. In *Loom Co. v. Higgins*, 105 U. S. 580, 591, this Court said:

“But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skilful persons”.

To the same effect see *Expanded Metal Company v. Bradford*, 214 U. S. 366, 381; *The Barbed Wire Patent*, 143 U. S. 275, 283. The fact that, once the solution is found, the step taken seems simple, so that it is a matter of surprise why it was not taken earlier, does not destroy the probative effect of a showing that in the face of the need therefor the art remained undeveloped for a long time until the invention of the patent in suit (*Richmond Screw Anchor Co. v. United States*, 275 U. S. 331, 339; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 434, 435; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 429; *Potts v. Creager*, 155 U. S. 597, 608; *DuBois v. Kirk*, 158 U. S. 58, 63). When, as here, the advance converted the slow and unprecise hand operation to speedy and accurate production, the commercial significance of the advance is also to be taken into consideration (*Hobbs v. Beach*, 180 U. S. 383, 393).

The foregoing principles are implicit in the decision of this Court in *Goodyear Tire & Rubber Company v. Ray-*

*O-I'ac*, 321 U. S. 275, 278, 279, wherein it was said, after reviewing the history of the art and the significance of Anthony's accomplishments:

"Viewed after the event, the means Anthony adopted seem simple and such should have been obvious to those who worked in the field, but *this is not enough to negative invention.*" (Emphasis ours)

In the face of this decision the Court of Appeals of the Second Circuit has reversed the District Court and overruled the Patent Office in according Danziger the status of an inventor as respects the subject matter of claims 1, 2 and 3.

While admitting a presumption that Danziger knew of the Siemens machine for the purpose of determining the quantum of Danziger's advance thereover, and apparently overlooking the evidence of use of the Siemens machine in the Siemens factory (R. 216, finding 20), the Court of Appeals denied any presumption that the other workers in the art knew of the Siemens machine for the purpose of determining if their failure to advance therebeyond suggested that more than the mere skill of the art was required to make the improvement in question. Thus the Court of Appeals has in effect imposed on plaintiff the improper burden of showing that the workers of the art knew of the Siemens British patent and why in the face of such knowledge they failed for twenty years to make the advance in question. This is going in the face of the uniform decisions of this Court that a patent is presumptively valid until the defendant sustains the burden of showing that an invention has not been made. It is contrary to the repeated rulings of this Court that the history of the art, when it shows a long unsatisfied demand, is cogent evidence on the issue of invention. It is substituting the intuition of the Court that the advance in question appears simple and should have been made earlier for what this Court has repeatedly accepted as persuasive of invention, to wit, the failure of

an art to advance for many years in the face of a need for improvement (*Goodyear Tire & Rubber Company v. Ray-O-Vac, supra*).

If, contrary to the rulings of this Court, the presumption that the state of the art is known to each worker therein is to be overthrown and the burden shifted to the patentee to show not only that the workers in the art were familiar with its closest prior development but why such workers failed at an earlier date to take the step forward upon which the patent has been granted, the *prima facie* validity of a patent becomes a mere empty formula. This is a matter of the widest public interest affecting all those who own or operate under patents. It is submitted that the ruling under discussion on the part of the Court of Appeals of the Second Circuit was in error and should be corrected.

#### **Point 2. Improper Reversal on Issue of Infringement.**

When, in the automatic operation of the machine hereinbefore referred to, the cutting elements are moved into contact with the strips of foil and paper to sever the same, there is a tendency for the strip to "belly away from the knife". To overcome this difficulty the Danziger machine includes means operable momentarily for increasing the tension of the strip at the time of the cutting.

Each of claims 9 to 12 in suit includes as an element of the combination "means operable in timed relation to the cutting means for momentarily increasing the tension of the strip". The District Court found as a fact that respondent's machines complained of included such means (R. 223, finding 53). The stipulated description of operation of the respondent's machines specifies "At or just prior to the time cutter 1 operates, the feed rolls 4 located just above cutter 1, are pinched together to engage the foil No. 1 and paper strips which pass between them. The machine is adjusted as accurately as possible so that cutter 1 cuts at the time rolls 4 pinch together" (R. 41) and

further that "Cam 24 is so positioned on shaft 13 that the rolls 4 close at a short time before or as the knives 1 operate to cut the paper and foil No. 1" (R. 43). The referred to tension arose whenever the diameter of the condenser exceeded 0.273 inch, and respondent stipulated that it had manufactured condensers of diameters as great as 0.35 inch (R. 224, findings 61, 62). Furthermore, defendant stipulated that it was common to change the mandrel and therefore defendant could at any time increase the diameter of the condenser so as to involve the infringing operation by mere change of the mandrel (R. 224, finding 65).

The District Court therefore found infringement of claims 9 to 12 because the machines complained of were manufactured to infringe and for at least part of the time were used in an infringing way. The Court of Appeals for the Second Circuit did not take exception to the above findings of fact. Indeed it conceded "\* \* \* it is true that there may be, and probably is, some such tension at the later stage of the winding of the larger condensers, and the Judge so found". However, the Court of Appeals substituted its own intuition as to the value of the provision in question, and on the ground that this apparently conceded use by defendant of what is defined in claims 9 to 12 in suit "\* \* \* is of too trifling importance to justify the intervention of a court", reversed the holding of infringement.

Whether or not infringement is proved when "\* \* \* the exact identity of the elements of the defendant's machine, their function and mode of operation, with the elements recited in those claims, and shown in the patent in suit" is shown (R. 222, finding 51), even though the defined combination is capable of a noninfringing use, has apparently not been decided by this Court, whereas the decision of the Court of Appeals of the Second Circuit in the instant case appears to be in conflict with the decisions of the Tenth Circuit Court of Appeals in *Stearns-Roger Mfg. Co. v. Ruth*, 87 F. (2d) 35, 38 and the Sixth Circuit Court of Appeals in *Farrington v. Haywood*, 35 F. (2d) 628, 631.

Infringement arises as a result of encroachment on any one of the three exclusionary rights of making, using and selling (*Bloomer v. McQuewan*, 14 Howard 539, 549, quoted with approval in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 425; *Birdsell v. Shaliol*, 112 U. S. 485, 487). The manufacture of the machines complained of, found as a fact to include the claimed "means operable in timed relation to the cutting means for momentarily increasing the tension of the strip" (R. 224, finding 65) was, under these decisions, an infringement even though no showing had been made that as used the aforesaid means were utilized part of the time.

The record shows that the means for increasing the tension is utilized whenever the diameter of the condenser exceeds 0.273 inch and that it was stipulated that defendant manufactured condensers as large as 0.35 inch in diameter (R. 224, findings 61, 62). Hence the machine was not only built with the capacity for infringement but also actually used in an infringing way.

This Court in *The Wood-Paper Patent*, 23 Wallace 566, 600, said:

"A single instance of using the combination would have amounted to infringement, and would have entitled the complainants to a decree."

Under this decision a single instance of the conceded use thus entitled petitioner to its decree. However, in disregard of the law as so stated by this Court, the Court of Appeals of the Second Circuit speculated as to the value of the infringing act—a matter going to the quantum of damages rather than to the fact of infringement—and reversed the District Court in its finding of infringement.

As the Supreme Court has apparently not passed on this issue as to whether infringement is shown when a machine is built with the capacity to infringe, even though some users thereof may not elect to use the infringing feature, and whether or not if infringing use is shown part

of the time the Court may rule that there is no infringement by speculating on the value of the infringing use, whereas the Courts of Appeals of other Circuits have ruled on these questions inconsistently with the herein decision of the Second Circuit Court of Appeals, the settling of this question by the Supreme Court is highly important in the interest of uniformity of decision.

### **Point 3. Failure to Follow Findings Below.**

The District Court, in addition to its opinion (R. 194) made extended findings of fact (R. 213-228) predicated on the testimony adduced by the parties during the trial. So far as here involved these findings were based on disputed issues of fact and predicated on the testimony. In reversing the District Court the Court of Appeals of the Second Circuit disregarded these findings of fact. This Court in *Adamson v. Gilliland*, 242 U. S. 350, 353 said:

“Considering that a patent has been granted to the plaintiff the case is preeminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses ‘depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.’ *Davis v. Schwartz*, 155 U. S. 631, 636.”

The validity of the claims in suit was under sharp attack, and much testimony was adduced by both sides with respect thereto (R. 124 et seq.; 169 et seq.). Hence there was both the conflict of testimony and the existence of evidence consistent with the findings of fact Nos. 11 to 38, inclusive, upon which the District Court reached its conclusion that an unsatisfied need existed for twenty years, from 1905 to 1925, until satisfied by the machine of the Danziger patent. The Court of Appeals, however, ignored these findings and erroneously found an absence of invention.



Upon the issue of infringement of claims 9 to 12, again there was sharp conflict in the testimony of the witnesses, and much testimony concerned with whether or not the machines complained of were built so as to have the capacity for infringement, whether or not in operation these machines were infringing at least part of the time, whether or not tension was applied momentarily to the strip at or just prior to the time of cutting, whether or not the application of this tension was incidental or deliberate, whether or not there was identity between the elements of the defendant's machine, their function and mode of operation, with the elements recited in the claims and shown in the patent in suit, etc. (R. 50-52, 64-68, 76 et seq., 105 et seq.). The District Court, having seen and heard the witnesses, made its findings on these disputed issues, predicated on the testimony, and found inter alia (R. 222 et seq.) that there was such identity of elements (finding 51) that defendant's momentary increase in the tension was not merely incidental (finding 53), that the tension was applied at or just prior to the cutting operation (findings 55, 56), that infringing use occurred whenever condensers exceeding 0.273 inch in diameter were wound and that defendant wound such larger condensers (findings 58-64), that defendant's machine was built to incorporate the combinations of claims 9 to 12 whether or not the means for applying tension was actually used (finding 65), etc.

If as ruled by this Court in *Adamson v. Gilliland*, *supra*, the findings of fact of the District Court under these circumstances should be "unassailable", the Court of Appeals could not properly ignore the findings that respondent deliberately included as an element of its machines the "means operable in timed relation to the cutting means for momentarily increasing the tension of the strip" (whether or not it was used), that such means was in fact used in winding all condensers whose diameters exceeded 0.273 inch, and that the elements of defendant's machine,

their function and operation, were in substance identical with the corresponding elements of the Danziger patented machine. Its reversal of the District Court in its finding of infringement was therefore erroneous.

### CONCLUSION.

Wherefore, petitioner prays that the petition for writ of certiorari be granted, the cause reviewed, and the decree of the Court of Appeals for the Second Circuit reversed.

Respectfully submitted,

LOYD H. SUTTON,  
*Attorney for Petitioner.*





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MAR 8 1945

CHARLES ELMORE GROPLEY  
CLERK

# Supreme Court of the United States

OCTOBER TERM, 1944

No. 970

CONDENSER CORPORATION OF AMERICA,

Petitioner-Plaintiff,

*v.*

MICAMOLD RADIO CORPORATION,

Respondent-Defendant.

On Petition for Writ of Certiorari to the Circuit Court  
of Appeals for the Second Circuit

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## BRIEF FOR RESPONDENT IN OPPOSITION

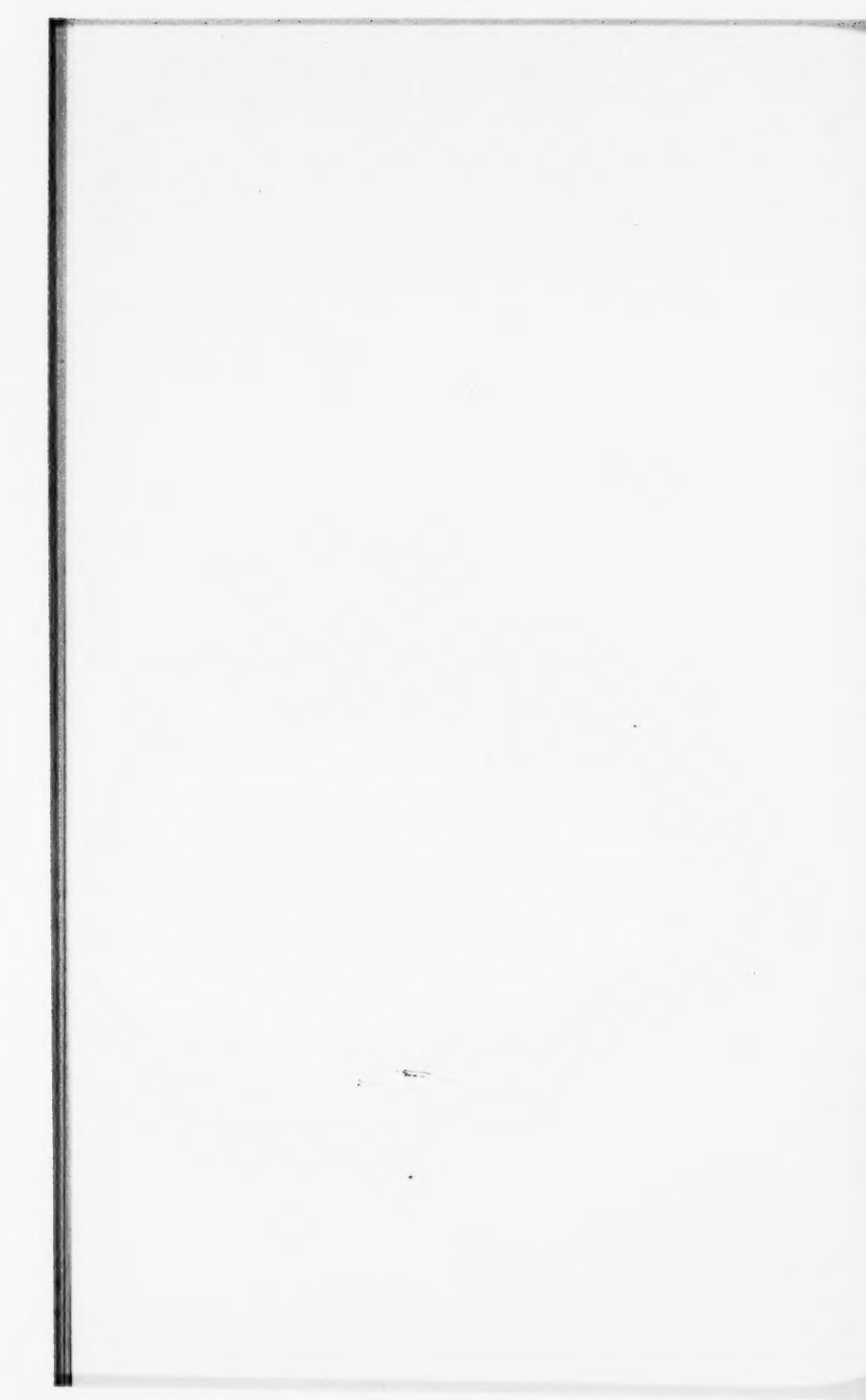
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225 Broadway,  
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# **Supreme Court of the United States**

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## **BRIEF FOR RESPONDENT IN OPPOSITION**

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### **Opinions Below**

The District Court's opinion (R. 194) is reported at 54 Fed. Supp. 327. The opinion of the Circuit Court of Appeals (R. p. 440) is reported at 145 Fed. 2nd 878.

### **Jurisdiction**

Petitioner invokes the jurisdiction of this Court under Title 28 U. S. C. Sec. 347.

## Questions Presented

This is an ordinary patent infringement suit, in which the Circuit Court of Appeals directed dismissal of the complaint on the ground that the Claims 1 to 3 of the patent in question are invalid, and that Claims 9 to 12 of such patent are not infringed by respondent's accused machine.

There has been no divergence of decision between different Circuit Courts of Appeal in respect to the Danziger Patent No. 1,940,847 here involved, but petitioner contends that in holding Claims 1 to 3 of said patent to be invalid, the Circuit Court of Appeals misinterpreted or failed to follow this Court's decision in *Goodyear Tire & Rubber Co. v. Ray-o-Vac*, 321 U. S. 275, and that the holding of non-infringement of Claims 9 to 12 was rendered despite proof that the accused machines were operated in an infringing manner for at least part of the time. Petitioner also contends that in reversing the District Court's decree the Circuit Court of Appeals failed to accord due weight to the Lower Court's fact findings on matters as to which the evidence is conflicting.

It is respondent's position (1) that the decision of the Circuit Court of Appeals is not in conflict with decisions of this Court, but merely weighed the particular facts involved in this case and applied well settled principles thereto, to find invention wanting in Claims 1 to 3 and non-infringement of Claims 9 to 12; (2) that there is in no substantial sense, conflicting evidence as to the facts upon which the judgment of the Circuit Court of Appeals was founded; (3) that the decision is of no general significance (beyond correctly weighing and adjudicating the particular facts involved) and consequently that none of the recognized grounds for favorable action upon the petition have been made to appear.

## STATEMENT

### (a) As to Claims 1 to 3

The mechanical matters involved are well set forth in the opinion of Circuit Judge Learned Hand, at R. 440-2, from which it will be gathered that the sequence of the paper and foil cutting operations set forth in Claims 1 to 3 of the Danziger patent is the same as in the prior art; and that Danziger's alleged point of novelty is (broadly and irrespective of any particular means employed) in mechanically interconnecting the two cutters so that one will operate before the other, instead of relying on manual manipulation by the operator to secure the same sequence of operation.

### (b) As to Claims 9 to 12

Judge Hand's opinion covers this phase of the case at R. 443-4 from which it will be noted that the infringement issue centered about the question of whether the accused machine has the "means for momentarily increasing the tension of the strip" at the time of cut, to which feature the claims under discussion are limited. Judge Hand discussed the evidence on the point, pointing out that in the operation of the accused machine "none but the larger condensers ever do become large enough" (R. 443) to permit any such increase in tension, and concluding that if this extra tension ever happens in the accused machine it is "of too trifling importance" and "obviously so useless in function" as not to "justify the intervention of a court" (R. 444). The above fact findings do not conflict with any concrete finding of the District Judge, whose decree of infringement was entered *without* any finding that this tension increasing feature is ever present in the accused machine to any *appreciable* or *useful* extent. And the findings of the Circuit Court of Appeals on the point were rendered on the testimony of the *petitioner's own* expert witness which appears at R. 81-85, without any conflicting evidence.

## ARGUMENT

### (a) As to Claims 1 to 3

As Judge Hand noted in the Court of Appeals opinion, Claim 1 alone need be considered (R. 440) and it is "a highly generalized statement" (R. 441) of the idea of mechanically securing the operation of the cutters in the desired order, instead of so doing by hand. The kernel of the Court of Appeals' opinion is to be found in the statement that it

"would be a gratuitous assumption that manufacturers, having learned from Siemens how to make condensers automatically, and how to secure an overlap of the paper strips (fol. 445) at the ends by manually cutting the foil earlier than the paper, had been obliged to wait twenty years for the notion alone that it would be desirable to gear the cutter in phase with the 'arbor'. Had it been the mechanical difficulties which baffled them, the delay might have been evidence of some invention; but that invention would have lain in contriving the solution, not in the discovery that a solution was desirable; which is all that the defendant can on any theory be thought to have borrowed from Danziger" (R. 443).

In other words, the petitioner is seeking to sustain a broad and abstract monopoly to the timing of operation of the cutters mechanically instead of by hand, and Judge Hand's disposition of this contention is unanswerably sound. If it be assumed, as petitioner contends, that there were difficulties in mechanizing the cutting operations which baffled those skilled in the art, then any invention arising out of the solution of these difficulties would necessarily lie in the *particular means* provided to overcome them, and no claim such as petitioner is making to mechanization in the abstract, would be justified (*Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, at p. 257). Furthermore such an assumption of genius needed to mechanize the cutting operations, flies directly in the face of the evidence of peti-

tioner's own expert who testified that given the idea of "the sequential operation of cutting the foil and paper," an engineer

"could have assembled these shafts and rollers and other parts to carry out that inventive concept. I attach considerable importance to Mr. Danziger's inventive idea of the sequence in which he was going to carry out these operations, and not too much importance to the mechanical details of carrying it out. I think they could be varied within very wide limits" (R. p. 89).

Beyond question, the "sequence" was in the prior art, and there was no evidence that those skilled in the art had been trying for years to mechanize these cutting operations and had been unable to do so. Thus the Court of Appeals in reaching its decision applied no new or unusual legal principles; the Court merely weighed the evidence and found that under the facts petitioner's case on invention does not measure up to the standards of the cases relied on in the petition.

#### (b) As to Claims 9 to 12

As already noted, *supra*, p. 3, the Court of Appeals' holding of non-infringement is predicated upon a finding that the tension increasing feature of these claims never appears in defendant's machine to any appreciable or useful extent, and this finding was made with neither substantial evidence nor any finding of the Lower Court to the contrary. The District Court simply overlooked the point, as the same District Judge had previously done in a case against the same defendant which was reversed by the same Circuit Court of Appeals on the same grounds (*Aerovox Corp. v. Micamold Radio Corporation* (C. C. A. 2), 92 Fed. 2nd 45, 46. Patents being limited by Statute to *useful* features (Title 35 U. S. C. Sec. 31), we do not think it is necessary to labor the point that a machine should not be

held to infringe under circumstances where a claimed feature never appears therein to any appreciable or useful extent.

### **Conclusion**

The decision below is correct. The questions presented involve only the application of well settled rules of law to facts peculiar to this case and are not of general importance, nor worthy of review in this Court.

Respectfully submitted,

KENNETH S. NEAL.  
Counsel for Respondent.

Dated, March 1945.

